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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,838	09/30/2003	Krista Bendig	06576.105115	6904

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EXAMINER

HILLERY, NATHAN

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/675,838	Applicant(s) BENDIG, KRISTA	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 10/01/03.
2. Claims 1 – 28 are pending in the case. Claims 1, 14 and 20 are independent.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14 – 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14 – 19 do not produce a concrete, useful, tangible result.
5. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. The term "relevant" in claim 6 is a relative term which renders the claim indefinite. The term "relevant" is not defined by the claim, the specification does not

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provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Consequently, the phrase "a subset of relevant tagged data items" has been rendered in definite.

9. The term "relevant" in claim 25 is a relative term which renders the claim indefinite. The term "relevant" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Consequently, the phrase "a subset of relevant tagged data items" has been rendered in definite.

10. **Further regarding claims 6 and 25**, the metes and bounds of "based on the nature of a search term" are unclear.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2, 6 – 22, and 25 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Maynard (US 6175830 B1).

13. **Regarding independent claim 1**, Maynard teaches that *The search module will utilize the search query to search through the database records 24a-24z so as to find the database records 30 matching the words or phrases in the search query* (Column 6, lines 58 – 61), compare with **locating one or more of the search results generated by the search of the electronic document**. Maynard further teaches that *In some instances, the finite element can be the entire document itself. The break module is also responsible for analyzing the contents of each finite element 20a-20z and creating a categorical tag 22a-22z for each finite element, which is to be inserted into the finite element* (Column 6, lines 13 – 18) and Maynard also teaches that *The index module parses through each of the finite elements created by the break module and creates a searchable database 23 including a database record 24a-24z for each of the finite elements created by the break module* (Column 6, lines 30 – 33), compare with **identifying each of the tagged data items present in the electronic document within a distance from each search result**. Maynard teaches that *Specifically, the hierarchy selection will inform the search module whether or not the search results are to be displayed in an order or structure based entirely upon the information contained within the categorical tags (research-centric)* (Column 6, lines 48 – 52), compare with **displaying the one or more tagged items identified as within the distance from each search result**.

14. **Regarding dependent claims 2, and 10 – 13**, Maynard teaches that *The break module 10 parses through an informational resource, such as a group of documents 18 to break up the group of documents into "finite elements" 20a-20z. Each finite element*

*is a user-defined "basket" of information from documents that is to be individually indexed and searched. The finite element is usually not a single word, phrase or symbol, but is a section or portion of an informational resource that can be identified and isolated by the break module. A simple example of a finite element would be the individual paragraphs of a document. Other examples of finite elements would include sub-chapters of a document, individual pages of a document, and other types of identifiable sections of a document. In some instances, the finite element can be the entire document itself (Column 6, lines 1 – 14), compare with **the distance from each search result comprises the distance between a first paragraph mark and a second paragraph mark, wherein one or more of the search results are located between the first paragraph mark and the second paragraph mark within the electronic document; calculating the distance between each search result and each tagged data item; and determining if the calculated distance is less than a distance criterion; the distance criterion is a number of lines of text; the distance criterion is a number of alphanumeric characters; the distance from each search result comprises a distance based on grammatical rules of a language comprising the electronic document.***

15. **Regarding dependent claim 7**, Maynard teaches that *From there, the user will make a selection 34 indicating to the un-break module 16 which of the finite elements the user wishes to view (Column 7, lines 14 – 16) as illustrated in Fig 1.34, compare with **each tagged data item is displayed as a hyperlink and each hyperlink***

corresponds to a location in the electronic document containing of the tagged data item.

16. **Regarding dependent claims 8 and 9**, Maynard teaches that *The categorical tag may also include an organizational attribute such as pertaining to the type of finite element or the location of the finite element within the document, a date stamp, a categorical word or phrase summarizing the contents of the finite element, etc.* (Column 6, lines 21 – 25), compare with **the one or more tagged data items belong to one or more categories of data; the categories of data comprise people's names, physical addresses, e-mail addresses, universal resource locators, dates, and telephone numbers.**

17. **Regarding dependent claim 6**, Maynard teaches that A second level of the display results may order the finite elements for each chapter based upon the weight or frequency that the search words or phrases appear within each finite element (Column 7, lines 4 – 7), compare with **the step of determining the tagged data items present in the electronic document within a distance from each search result that comprise a subset of relevant tagged data items based on the nature of a search term prior to display the tagged data items.**

18. **Regarding claims 14 – 19**, the claims incorporate substantially similar subject matter as claims 1, 2, 6 – 13 and are rejected along the same rationale.

19. **Regarding claims 20, 21, 22, 25 – 28**, the claims incorporate substantially similar subject matter as claims 1, 2, 6 – 13 and are rejected along the same rationale.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 3 – 5, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maynard (US 6175830 B1) as applied to claims 1, 14, and 20 above, and further in view of Kadayam et al. (US 20030212673 A1).

22. **Regarding dependent claims 3 and 4**, Kadayam et al. illustrate in Figure 3 an example screen-shot of the exemplary embodiment, compare with **the one or more tagged items identified as within the distance from each search result are displayed by a user interface in a window separate from a window displaying content of the electronic document; any of the tagged items identified as within the distance from each search result are displayed at the top of the separate window and the one or more search results are displayed beneath the displayed tagged data items** (Fig 3. 44). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Maynard with that of Kadayam et al. because such a combination would provide the users of Maynard with *an enterprise-scale system and method for searching and retrieving electronic information from disparate electronic information sources within a large organization (an intranet) and/or from the Internet* (p 1, paragraph block 0006).

23. **Regarding dependent claim 5**, Kadayam et al. illustrate in Figure 16 an example screen shot of the exemplary embodiment, compare with **each tagged item identified as within the distance from one or more search result is displayed adjacent to the search result in the separate window**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Maynard with that of Sumita et al. because such a combination would provide the users of Maynard with *an enterprise-scale system and method for searching and retrieving electronic information from disparate electronic information sources within a large organization (an intranet) and/or from the Internet* (p 1, paragraph block 0006).
24. **Regarding claims 23 and 24**, the claims incorporate substantially similar subject matter as claims 3 – 5 and are rejected along the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a stylized, sweeping flourish extending to the right.

Doug Hutton
Primary Examiner
Art Unit 2176

NH